

## R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

### SUMMARY OF TELEPHONE INTERVIEW

A telephone interview was held on April 9, 2008 between Applicant's representative, Robert Miller, Examiner Oveissi and the Examiner's supervisor, Huy Vu. The objection to the phrase "capable of," the rejection of claims 1-29 and the references Huch and Upp were discussed. Applicant's representative pointed out that Examiner Oveissi appeared to be applying MPEP §2111.04 improperly as a per se rule. Applicant's representative pointed out that rather than being a bar to particular clauses, MPEP §2111.04 appeared to be a guideline for an Examiner to identify when special attention should be paid to the claim language and as such, the claim language still needed to be addressed rather than ignored.

Specifically, Applicant's representative directed Examiner Oveissi and Examiner Vu to the text of MPEP §2111.04 which stated that the determination of whether each of the clauses identified in MPEP §2111.04 is a limitation in a claim depends on the specific facts of the case, and that the Federal Circuit has held that when a whereby clause states a condition that is material

to patentability it cannot be ignored in order to change the substance of the invention. Applicant's representative pointed out that Examiner Oveissi had performed no analysis explaining why the phrase "capable of" as used in the pending claims was considered not to state a condition that was material to patentability. Since the Examiner had not made a case for the clause "capable of" not stating a condition that is material to patentability, the Examiner could not ignore the language in the claims to change the substance of the invention under MPEP §2111.04.

Applicant's representative further pointed out that Examiner Oveissi had stated in the Office Action that the phrase "and maintaining an order of input columns within each of the plural tributary payloads," which had been added to claims 1, 14 and 27 in the previous response, was not considered as a claim limitation. Applicant's representative pointed out that the MPEP instructs that all of the words of a claim are to be addressed when applying a prior art rejection (see MPEP §2173.06) and, therefore, the Office Action was not complete as required under 37 CFR 1.104(b).

Furthermore, Applicant's representative pointed out that the phrase "and maintaining an order of input columns within each of the plural tributary payloads," which had been incorporated in the independent claims, and which the Examiner stated was not

considered as a claim limitation, was from respective dependent claims which the Examiner had indicated contained allowable subject matter (see page 5 of the Office Action dated August 7, 2007). Agreement was reached that Examiner Oveissi would consider whether replacing the phrase "capable of being switched" with the word "switchable" would be acceptable in overcoming the objection and materially advance the prosecution of the present application with Examiner Oveissi considering the material added to the independent claims in the previous response.

In a follow-up conversation between Examiner Oveissi and Applicant's representative on April, 14, 2008, Examiner Oveissi stated that replacing the phrase "capable of being switched" with the word "switchable" would be acceptable and would remove the Examiner's objection to the claims. Examiner Oveissi further stated that with the replacement of the phrase "capable of being switched" with the word "switchable" the previous incorporation of the phrase "and maintaining an order of input columns within each of the plural tributary payloads" in the independent claims would overcome the current prior art, but a further search would have to be performed.

**SHOWING UNDER 37 CFR §1.116**

After a final rejection, an amendment canceling claims or

complying with any requirement of form expressly set forth in a previous Office Action may be made (37 CFR §1.116(b)(1)). An amendment presenting rejected claims in better form for consideration on appeal may be admitted (37 CFR §1.116(b)(2)). The amendments presented herein clearly are complying with a requirement expressly set forth in the Office Action dated August 7, 2007 and in the final Office Action dated January 25, 2008.

Furthermore, the amendments involve incorporating subject matter from dependent claims which had been indicated as including allowable subject matter and, therefore, are believed to better focus, if not remove issues for appeal, or require only a cursory review by the Examiner. As such, the amendments presented herein are believed to be compliant with the showing requirement under 37 CFR §1.116(b)(1 and 2) and Applicant respectfully requests that the amendments be admitted.

#### **CLAIM OBJECTIONS**

The objection to claims 1, 9, 14, 27, 28 and 29 has been obviated by amendment and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-29 under 35 U.S.C. §103 as being unpatentable over Huch et al. (U.S. Patent No. 6,421,770; hereinafter Huch) in view of Upp (U.S. Patent No. 4,998,242) has been obviated by amendment and should be withdrawn.

In contrast to the cited references, the presently claimed invention (claim 1) provides a method of switching comprising, in parallel with writing, reading from the common buffer to output columns of an output data stream according to a read pointer, the read pointer selecting, for each of the output columns, an input column from a limited portion of the common buffer that contains a set of the input columns that are switchable in time to the corresponding output column according to a communication protocol and **maintaining an order of input columns within each of the plural tributary payloads**. Claims 14 and 27 include similar limitations. The cited references do not appear to teach or suggest maintaining an order of input columns within each of the plural tributary payloads, as presently claimed in light of the indication of allowable subject matter (see section 3 on page 5 of the Office Action dated August 7, 2007). As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Claims 2-13 and 15-29 depend, directly or indirectly,

from either claim 1 or claim 14 which are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejections should be withdrawn.

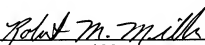
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative between the hours of 9 a.m. and 5 p.m. ET at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,

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Dated: April 18, 2008

c/o David Smith  
LSI Corporation

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